


**TERMINAL DISCLAIMER TO OBIVATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**

 Docket Number (Optional)
980049.410C1

In re Application of: Richard Martin et al.

Application No. 10/717,049

Filed: November 18, 2003

For: HETEROCYCLIC MODULATORS OF NUCLEAR RECEPTORS

The owner*, X-Ceptor Therapeutics, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. 6,696,473 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
 is held unenforceable;
 is found invalid by a court of competent jurisdiction;
 is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
 has all claims canceled by a reexamination certificate;
 is reissued; or
 is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any

terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Registration No. 32,783

Carol J. Roth
Signature

November 22, 2005
Date

Carol J. Roth
Typed or printed name

206-622-4900
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act. 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2005

Complete if Known

| | |
|----------------------|--------------------|
| Application Number | 10/717,049 |
| Filing Date | November 18, 2003 |
| First Named Inventor | Richard Martin |
| Examiner Name | Deborah C. Lambkin |
| Art Unit | 1626 |
| Attorney Docket No. | 980049.410C1 |

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

METHOD OF PAYMENT (check all that apply)

- ☒ Check ☐ Credit Card ☐ Money Order ☐ Other (please identify): _____
☒ Deposit Account Deposit Account Number: 19-1090 Deposit Account Name: Seed IP Law Group PLLC
 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**
☐ Charge any additional fee(s) or underpayments ☒ Charge any underpayments or credit any overpayments of fee(s) under 37 CFR 1.16 and 1.17

Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | _____ |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | _____ |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | _____ |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |
|--|--------------|----------|---------------|---------------------------|
| 62 | -66 (HP) = 0 | X | _____ | Fee (\$) |
| HP = highest number of total claims paid for, if greater than 20 | | | | Fee Paid (\$) |

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|---------------|--------------|----------|---------------|
| 17 | -18 (HP) = 0 | X | _____ |

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)) the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|--|----------|---------------|
| _____ | -100 = _____ | /50 = _____ (round up to a whole number) | x _____ | _____ |

4. OTHER FEE(S)

| Non-English Specification, \$130 fee (no small entity discount) | Fees Paid (\$) |
|--|----------------|
| Other (e.g., late filing surcharge): Terminal Disclaimer (Fee code 1814) | 130 |

SUBMITTED BY

| | | | | | |
|-------------------|---------------|-----------------------------------|-------------------|-----------|--------------|
| Signature | Carol J. Roth | Registration No. (Attorney/Agent) | 32,783 | Telephone | 206-622-4900 |
| Name (Print/Type) | Carol J. Roth | Date | November 22, 2005 | | |